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SHERRILL LAW OFFICES 4756 BANNING AVE SUITE 212 WHITE BEAR LAKE, MN 55110-3205			RESTIFO, JEFFREY J	
			ART UNIT	PAPER NUMBER
			3618	

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/804,769  
Filing Date: March 13, 2001  
Appellant(s): CARDINAL ET AL.

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Michael S. Sherrill  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 3, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

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4,522,280

BLANEY

6-1985

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phung et al. (6,370,469 B1) and in further view of Blaney (4,522,280 A).

With respect to claims 1, 8, 11, and 16, Phung et al. discloses a microcontroller system 104 for altering the condition of a cruise control system 100 for a motorized vehicle when the vehicle experiences lateral acceleration in excess of a threshold value, said lateral acceleration being determined by a sensor (or accelerometer) 106, as recited in column 1, lines 11-47. Phung et al. does not disclose the control system as disengaging the cruise control based on the sensed value exceeding the threshold value. Blaney does disclose a control device for disengaging a cruise control in response to a sensed value exceeding a threshold value, as recited in column 2, lines 65-69. It would have been to one having ordinary skill in the art at the time of the invention to have provided the control system of Phung et al. with the disengagement

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option of Blaney in order to prevent unwanted acceleration of the vehicle in an emergency situation.

With respect to claims 2-5 and 12-15, the control system of Phung et al. and Blaney can be applied to any type of vehicle, further, the type of vehicle the system is applied to is an intended use and therefore has been given little patentable weight. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the control system of Phung et al., as modified by Blaney, to any type of vehicle in order to achieve the same safety benefits.

With respect to claim 7, 9, and 10, pendulum accelerometers and other mechanical switches are well-known in the art and are not viewed as patentable unless their use produces an unexpected result. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the control system of Phung et al., as modified by Blaney, with a pendulum accelerometer or mechanical switch in order to reduce the amount of electrical parts and reduce repair costs.

With respect to claim 17, the method recited in this claim is inherently performed in the use of the control system of Phung et al. and Blaney, as described above.

**(11) Response to Argument**

In response to appellant's argument that the references must explicitly provide a suggestion for combining, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish* 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500

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(Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

In this case, Phung et al. discloses a control system that senses and compares a sensed lateral acceleration value with a predetermined threshold value and performs a variety of functions, such as braking, accelerating, etc. The act of disengaging the

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cruise control is conventionally performed when brakes are applied, however the examiner submitted the control system of Blaney as evidence of a control system that disengages the cruise control system in direct response to a comparison of a sensed parameter, such as braking, in view of a predetermined threshold value, as explicitly recited in column 2, lines 65-68 and in the latter part of the abstract. The function of disengaging the cruise control system is a well-known safety precaution that can be performed in response to an infinite amount of parameters, lateral acceleration being one of many well-known parameters which are often measured in moving vehicles for controlling devices, Phung et al. being one of many cited references which measure lateral acceleration for vehicle control parameter means.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The appellant appears to argue against the references separately as opposed to the combination of the two. Further, the motivation to combine the references of Phung et al. with Blaney is knowledge that is generally available to one of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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JJR  
September 2, 2004

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